

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 4-5, 7-10, 12-16, and 18-19 are pending in the application, with claims 1, 7, 12, and 16 being the independent claims. Claims 1, 7, 8, 9, 10, 12-16 and 18 are sought to be amended. Claims 6 and 11 are sought to be cancelled without prejudice or disclaimer of the subject matter therein. Applicants reserve the right to prosecution similar or broader claims, with respect to the amended or cancelled claims, in the future. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 12-16, 18, and 19 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. For the reasons set forth below, Applicants respectfully traverse.

Enablement

The Examiner states that the claims fail to comply with the enablement requirement because the original specification does not disclose or support the claim language “a computer program product,” “computer executable instructions recorded,” “computer program instructions recorded,” “computer useable medium,” or “tangible computer useable medium.” (Office Action, p. 3.)

The Examiner is reminded that, pursuant to M.P.E.P. § 2164, Applicants need only describe the claims in the specification so that one of ordinary skill in the art can practice the invention without undue experimentation. *See also In re Wands*, 858 F.2d 751 (Fed. Cir. 1998). It is long established law that a specification is not required to recite what is well known information to one of ordinary skill in the art or readily understood by practitioners. *See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc.* 82 F.2d 1367 (Fed. Cir. 1986) *cert denied*, 480 U.S. 947 (1987); *Amtel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374 (Fed. Cir. 1999); *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364 (Fed. Cir. 2001); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313 (Fed. Cir. 2003). The Federal Circuit has held in these cases that (a) not requiring this in the specification is to avoid having specifications of enormous and unnecessary length, (b) not requiring this in the specification is allowed because a patent is not a scientific treatise, but a document that presumes a readership skilled in the field of the invention, such that the document is written for persons experienced in the field of the invention, and (c) “The [enablement] requirement is satisfied if, given what they already know, the specification teaches those in the art that they can make and use the invention without undue experimentation.”

Nevertheless, Applicants contend that support is contained within the specification of the present application for the claim language noted above. For example, FIG. 2, element 12 clearly illustrates memory “for storing a control program and various data.” (Specification, p. 5, ll. 24-25.) Applicants respectfully submit that a person skilled in the art would clearly understand the term “memory” to encompass at least “computer readable medium,” “computer readable storage medium,” and “computer

useable medium.” Even further, Applicants respectfully submit that a person skilled in the art would clearly understand “a control program” stored within the “memory” as encompassing at least “computer executable instructions recorded” or “computer program instructions recorded.”

In the Response to Arguments section of the present Office Action, the Examiner contends that the exemplary support cited by the Applicants above “is insufficient because in FIG. 2, page 5 of the specification the disclosure is for ‘storing a control program’ and not for ‘a computer program product’ as claimed in claims 12-19.” (Office Action, p. 16.) Applicants respectfully disagree. Applicants do not assert that the “memory,” illustrated in FIG. 2 of the specification, is for storing a computer program product as the Examiner alleges. Rather, Applicants assert that the “memory” is capable of storing “a control program” (as explicitly stated in the specification) that, as is well known to one of ordinary skill in the art, contains computer program instructions or computer executable instructions. The “memory”—containing the “control program”—represents a computer program product.

In the event the Examiner maintains the rejection of claims 12-16, 18, and 19 under 35 U.S.C. § 112, first paragraph, Applicants respectfully request a more detailed explanation of how the present disclosure does not provide sufficient enablement of claims 12-16, 18, and 19. Specifically, Applicants respectfully request that, pursuant to MPEP 2164.02:

The language [employed by the examiner in making the rejection] should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. (*emphasis in original*)

In view of the above, Applicants respectfully request that the rejection of claims 12-16, 18, and 19 under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

Written Description

When reviewing the Examiner's language in both the rejection at paragraph 3 of the Office Action and Section b. of the Response to Arguments in the Office Action, it appears to the Applicants the Examiner is rather arguing the claims allegedly fail to meet the written description prong of 35 U.S.C. 112, 1st paragraph, and not that the claims fail to meet the enablement prong, as stated in paragraph 3 of the final Office Action. Applicants believe the claims meet both prongs of the statute.

Pursuant to M.P.E.P § 2163, e.g., §2163(III)(A), the Examiner has failed to establish a *prima facie* case under 35 U.S.C. §112, first paragraph, that the instant specification does not include adequate written description to support the claimed features. This is because the Examiner has failed to meet the initial burden of rebutting the presumption that the written description is adequate by presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the embodiment of invention defined by the claims. See, e.g., *In re Wertheim*, 541 F.2d 257, 263, 191 U.S.P.Q. (BNA) 90, 97 (CCPA 1976). For example, the Examiner has not, in rejecting the claims, set forth express findings of fact regarding his analysis that supports the lack of written description conclusion.

As the Examiner well knows, the Statute at 35 U.S.C. §112, first paragraph, "ensures that, as of the filing date, the inventor conveyed with reasonable clarity to those

of skill in the art that he was in possession of the subject matter of the claims.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 U.S.P.Q.2D (BNA) 1111, 1117 (Fed. Cir. 1991). “The Patent Act and [the Federal Circuit] case law require only sufficient description to show one of skill in the ... art that the inventor possessed the claimed invention at the time of filing.” *Union Oil Co. v. Atl. Richfield Co.*, 208 F.3d 989, 997, 54 U.S.P.Q.2D (BNA) 1227 (Fed. Cir. 2000).

In regards to possession, the Examiner well knows the written description requirement does not require the applicant “to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012, 10 U.S.P.Q.2D (BNA) 1614, 1618 (Fed. Cir. 1989) (citations omitted). Possession may be shown by a clear depiction of the claimed features in detailed drawings or in structural chemical formulas that permit a person skilled in the art to clearly recognize that applicant had possession of the claimed features. Also, an adequate written description of the claims showing the inventor had possession of the claimed features, may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed features. See, e.g., *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000).

With respect to claim language being exactly described in the written description, it is well understood that “[the applicant] does not have to describe exactly the subject matter claimed.” *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1533, 25 U.S.P.Q.2D (BNA) 1241, 1245. Rather, “the primary consideration is factual and

depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure.” *In re Wertheim*, 541 F.2d at 262, 191 U.S.P.Q. at 96 It has been held that “[t]he written description requirement does not require identical descriptions of claimed compounds, but it requires enough disclosure in the patent to show one of skill in this art that the inventor ‘invented what is claimed.’” *Vas-Cath*, 935 F.2d at 1563. Lacking exact examples in the specification does not mean the claims do not meet the requirements of this section of the statute because “[a] claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language.” See *Union Oil Co.*, at 997.

The instant and originally filed specification clearly supports, pursuant to the case law above, the claimed features noted by the Examiner, as discussed above in rebutting the enablement rejection. Based on the case law discussed above, the above sections of the specification clearly show the inventor was in possession of the claimed features, as would be understood to those of skill in the art.

Accordingly, for this additional reason, Applicants respectfully requests that the Examiner reconsider and withdraw the rejection.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 12-16, 18, and 19 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claims 12 and 16, the Examiner states that “the phrase(s) ‘tangible computer useable medium (or computer useable medium) having computer program (or instructions) recorded thereon....’ is vague and indefinite because it is unclear how a computer useable medium can store computer program or instructions.” (Office Action, p. 4.) Without acquiescing to this rejection, and merely to expedite prosecution, Applicants have amended claims 12 and 16 to recite a “tangible computer readable storage medium.” As is well known to one of ordinary skill in the art, a computer readable storage medium may be configured to store a computer program or instruction. Accordingly, Applicants respectfully request that the rejection of claims 12 and 16 under 35 U.S.C. § 112 be reconsidered and withdrawn.

In regard to claims 13-15, the Examiner states that there is “insufficient antecedent basis” for the language “computer readable medium.” (Office Action, p. 4.) Without acquiescing to this rejection, and merely to expedite prosecution, Applicants have amended the cited language of claims 13-15 to recite “computer program product.” Applicants submit that this amendment corrects any antecedent basis problem with claims 13-15. Accordingly, Applicants respectfully request that the rejection of claims 13-15 under 35 U.S.C. § 112 be reconsidered and withdrawn.

In regard to claim 18, the Examiner states that there is “insufficient antecedent basis” for the language “computer program logic.” (Office Action, p. 5.) Without acquiescing to this rejection, and merely to expedite prosecution, Applicants have amended claim 16 to recite “a tangible computer readable storage medium having computer program logic recorded thereon.” Claim 18 depends from claim 16. Therefore, Applicants submit that this amendment corrects any antecedent basis problem

with claim 18. Accordingly, Applicants respectfully request that the rejection of claim 18 under 35 U.S.C. § 112 be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1, 5, 7-10, 12-16, 18, 19

Claims 1, 5, 7-10, 12-16, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,094,423 to Alfano et al. (“Alfano”) in view of U.S. Pre-Grant Publication No. 2002/0099632 to Yanagidate et al. (“Yanagidate”). For the reasons set forth below, Applicants respectfully traverse.

Claims 1, 7, 12, and 16 recite features that distinguish over the applied references.

For example (emphasis added), claim 1 recites “a determining device configured to select a most appropriate packet unit for transmission data to be packetized that **minimizes the amount of transmission data**,” claim 7 recites “selecting a packet unit, recognizable by the destination communication device, **to minimize the amount of transmission data**,” claim 12 recites “selecting a packet unit recognizable by the destination communication device **to minimize an amount of transmission data** for the packet unit based on data communication rates,” claim 16 recites “selecting means for enabling the processor to select a packet unit recognizable by the destination communication device **to minimize an amount of transmission data** for the packet unit based on data communication rates.”

The Examiner appears to incorrectly equate the scheme of transitioning from a transaction protocol to a connection-oriented protocol, disclosed in Alfano, with

minimizing the amount of transmission data, as respectively recited in claims 1, 7, 12, and 16. Applicants respectfully disagree with the Examiner's position.

Alfano is directed to a system and method for linking a transaction protocol and a connection-oriented protocol in a wireless communication protocol device. Alfano teaches that a transaction protocol, in comparison to a connection-oriented protocol, "has a low implementation and operating cost." (Alfano, 2:34-36.) However, Alfano notes the use of a transaction protocol is not always possible. Transaction protocols are "designed around a maximum amount of data being allowed to be transmitted in each message exchange." (Alfano, 2:31-34.) As such, the use of a connection-oriented protocol is required in instances where the maximum amount of data to be transmitted exceeds this limit of a transaction protocol, i.e., the maximum transfer unit (MTU) size. Alfano teaches "an ideal solution" is performed by using the transaction protocol in cases where the transaction protocol is sufficient to carry messages "and a connection-oriented protocol in all other cases." (Alfano, 2:50-54.)

Transaction protocols, as specifically disclosed in Alfano, simply include "a short request for information by an initiator and a response to the request from the recipient." (Alfano, 2:15-17.) Consequently, only a single message is transmitted from both the initiator and the recipient in a single transaction. If the response to a request sent by an initiator is greater than a single maximum transmission unit (MTU), the responder (i.e., the recipient) will segment the message and eventually begin to execute a connection-oriented protocol. (Alfano, 5:64-67 and 6:1-42.)

In summary, the transition in Alfano from a transaction protocol to a connection-oriented protocol occurs when a message to be transmitted has a message length greater

than a single MTU. As a result, the message is segmented into smaller message sizes and transmitted via a connection oriented protocol.

However, Alfano does **not** teach or suggest that the message segments are selected to **minimize the amount of transmission data**, as respectively recited in claims 1, 7, 12, and 16. Rather, in Alfano the message segments are at most selected to be less than a single MTU, which does not, in any way, relate to **minimizing the amount of transmission data**, as respectively recited by claims 1, 7, 12, and 16.

Yanagidate does not cure the deficiencies of Alfano noted above. Yanagidate is used on page 7 of the present Office Action to teach transmitting packet units to a destination device that are recognizable by a destination device. Even assuming this is a correct interpretation by the Examiner, which Applicants do not acquiesce to, Yanagidate does not provide the missing teaching or suggestion with respect to claims 1, 7, 12, and 16 as noted above. Therefore, the applied references cannot be used to establish a *prima facie* case of obviousness for claims 1, 7, 12, and 16.

Dependent claims 4 and 5 are similarly not rendered obvious by the combination of Alfano and Yanagidate for the same reason as independent claim 1, from which they depend, and further in view of their own respective features. Also, dependent claims 8-10 are likewise not rendered obvious by the combination of Alfano and Yanagidate for the same reasons as claim 7, from which they depend, and further in view of their own respective features. Further, dependent claims 13-15, 18, and 19 are likewise not rendered obvious by the combination of Alfano and Yanagidate for the same reasons as claim 12 and 16, from which they respectively depend, and further in view of their own respective features.

Accordingly, Applicants respectfully request that the rejection of claims 1, 5, 7-10, 12-16, 18, and 19 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claims 6 and 11

Claims 6 and 11 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Yanagidate in view of Alfano. Although Applicants believe claims 6 and 11 are patentable over the applied references, and without acquiescing to the propriety of the rejection, claims 6 and 11 have been cancelled by the above amendment, thereby rendering the rejection of those claims moot.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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